

## REMARKS

In the Office Action mailed September 12, 2002, Claims 1 and 5 are rejected under 35 U.S.C. §102(b), as being anticipated by DE 197 02 431 in the name of Meisen. Claim 1 is rejected under 35 U.S.C. §102(b), as being anticipated by U.S. Pat. No. 5,599,627 issued to Aoki et al. Claim 1 is rejected under 35 U.S.C. §102(b), as being anticipated by JP 7-240306 in the name of Aoki et al. Claim 1 is rejected under 35 U.S.C. §102(b), as being anticipated by U.S. Pat. No. 5,885,740 issued to Tokunaga et al. Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 14 and 15 of copending application Serial No. 09/994,880. Claims 1-5 are rejected under 35 U.S.C. §112, second paragraph as being indefinite.

### I. Rejections under 35 U.S.C. §112, second paragraph

Claims 1-5 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite.

In the instant Office Action, the Examiner contends that the claims are indefinite because the basis for the weight percentage of silicon has not been specified. Applicant respectfully disagrees and points the Examiner to page 9, paragraph 4, where the elemental analysis for Si and Mn is set forth (spectroanalytically by ICP-OES) and to page 10, paragraph 7, where the elemental analysis for S is set forth (also by ICP-OES).

As far as ICP-OES is concerned, this elemental analytic method is known in the art and is set forth in numerous patents, such as at col. 4, lines 44 to 45 of US 6,280,649 B1 (copy enclosed herewith for the Examiner's convenience). The examples of that patent clearly state that the Si content is a weight percentage of magnetite. In the instant application, therefore, the elemental analysis of Si and S are given in percent by weight of the magnetite toner. The Examiner's attention in this regard is also directed to page 4, line 32, of DE 197 02 431 C2. Applicant also includes herewith a declaration detailing how he determined the weight percentages by the ICP-OES method for Si, Mn and S in the instant application.

Applicant has amended Claim 1 to add the phrase "based on the weight of the magnetite toner" thereto to further clarify the claimed subject matter.

The Examiner also contends, in the instant Office Action, that the method of determining sphericity is not provided in the specification. Applicant respectfully disagrees and points the Examiner to page 10, paragraph numbered 8, which states that the "shape factor method" was used. An explanation of the "shape factor method" is set forth, amongst others, in US 5,652,060 (at col. 20, lines 26 et seq.). The enclosed declaration of Dr. Meisen also details how the sphericity determinations were made in the instant application.

Applicant submits that because of the above-detailed changes, the claims are in compliance with 35 U.S.C. §112, second paragraph, and respectfully requests the Examiner reconsider and reverse his rejection of Claims 1-5 under 35 U.S.C. §112, first paragraph, as being indefinite.

## II. Rejections under 35 U.S.C. §102(b)

### A. As anticipated by Meisen

Claims 1 and 5 are rejected under 35 U.S.C. §102(b), as being anticipated by DE 197 02 431 in the name of Meisen. Applicant respectfully disagrees with the Examiner.

Applicant reminds the Examiner that as stated in MPEP §2131, to anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully contends that the Examiner has failed to point to where Meisen does so.

Specifically, Meisen fails to disclose or suggest the instantly claimed limitation that the low-silicon magnetites have a silicon content of less than 0.05 wt% based on the weight of the magnetite toner.

Therefore, applicant respectfully requests the Examiner reconsider and reverse his rejection of Claims 1 and 5 under 35 U.S.C. §102(b), as being anticipated by DE 197 02 431 in the name of Meisen.

**B. As anticipated by U.S. Pat. No. 5,599,627 issued to Aoki et al.**

Claim 1 is rejected under 35 U.S.C. §102(b), as being anticipated by U.S. Pat. No. 5,599,627 issued to Aoki et al (Aoki '627). Applicant respectfully disagrees with the Examiner.

Applicant again reminds the Examiner of his obligation under MPEP §2131, and contends that Aoki '627 fails to disclose or suggest the instantly claimed limitation that the low-silicon magnetites have a silicon content of less than 0.05 wt% based on the weight of the magnetite toner.

Therefore, applicant respectfully requests the Examiner reconsider and reverse his rejection of Claim 1 under 35 U.S.C. §102(b), as being anticipated by U.S. Pat. No. 5,599,627 issued to Aoki et al.

**C. As anticipated by JP 7-240306 in the name of Aoki et al**

Claim 1 is rejected under 35 U.S.C. §102(b), as being anticipated by JP 7-240306 in the name of Aoki et al (Aoki '306). Applicant respectfully disagrees with the Examiner.

Applicant again reminds the Examiner of his obligation under MPEP §2131, and contends that Aoki '306 fails to disclose or suggest the instantly claimed limitation that the low-silicon magnetites have a silicon content of less than 0.05 wt% based on the weight of the magnetite toner.

Therefore, applicant respectfully requests the Examiner reconsider and reverse his rejection of Claim 1 under 35 U.S.C. §102(b), as being anticipated by JP 7-240306 in the name of Aoki et al.

**D. As anticipated by Tokunaga et al.**

Claim 1 is rejected under 35 U.S.C. §102(b), as being anticipated by U.S. Pat. No. 5,885,740 issued to Tokunaga et al. Applicant respectfully disagrees with the Examiner.

Applicant again reminds the Examiner of his obligation under MPEP §2131, and contends that Tokunaga et al. fails to disclose or suggest the instantly claimed limitation that the low-silicon magnetites have a silicon content of less than 0.05 wt% based on the weight of the magnetite toner.

Therefore, applicant respectfully requests the Examiner reconsider and reverse his rejection of Claim 1 under 35 U.S.C. §102(b), as being anticipated by U.S. Pat. No. 5,885,740 issued to Tokunaga et al.

### **III. Rejections under judicially created doctrine of obviousness type double patenting**

Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 14 and 15 of copending application Serial No. 09/994,880.

Applicant requests the Examiner hold this rejection in abeyance until such time as Claims 14 and 15 of copending application Serial No. 09/994,880 are patented.

### **Conclusion**

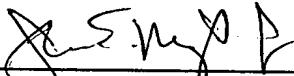
Applicant has amended Claim 1 and contends that such amendment adds no new matter and finds support in the specification. Attached hereto, please find a page captioned "Version with markings to show changes made."

Applicant submits that the instant application is in condition for allowance. Accordingly, reconsideration and a Notice of Allowance are respectfully requested for Claims 1-5. If the Examiner is of the opinion that the instant application is in

condition for other than allowance, he is requested to contact the applicant's Attorney at the telephone number given below so that additional changes to the claims may be discussed.

Respectfully submitted,

By



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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE SPECIFICATION:**

The specification has been amended to correct a typographical error.

**IN THE CLAIMS:**

Claim 1 has been amended as follows:

1.(Amended) A toner comprising low-silicon magnetites, wherein the low-silicon magnetites have a silicon content of less than 0.05 wt% based on the weight of the magnetite toner.